

REMARKS/ARGUMENT

Description of amendments

Applicant has amended claim 1, rewritten claim 5 in independent form, and added new claims 21-25. As amended, claims 1-10 and 21-25 are now pending and under examination, and claims 11-20 have been withdrawn.

Allowable Claim

Applicant appreciates that the Examiner indicated that claim 5 would be allowable if it is rewritten to include all of the limitations of the base claim. Claim 5 has been rewritten to include all of the limitations of the base claim. Accordingly, claim 5 is in allowable form.

Rejections under 35 U.S.C. §102(b)

Claims 1, 4 and 6-10 were rejected under 35 U.S.C. §102(b) as being anticipated by *Kropfield* (U.S. Patent 5,810,254). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections.

Independent claim 1 recites several limitations that are not taught by *Kropfield*. For example, claim 1 recites that “the solvent mixes with the polymer only after the polymer and solvent are dispensed out from the nozzle assembly....” In *Kropfield*, the first and second materials are mixed inside the spray gun, and then the mixture is discharged through a main outlet (column 9, lines 60-64).

Additionally, *Kropfield* does not anticipate claim 1 because it does not contain an enabling disclosure. The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). In *Kropfield*, the drawings do not have any of the reference numerals used in the specification. As a result, a person with ordinary skill in the art cannot produce *Kropfield's* device without undue experimentation.

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In view of the above discussions, Applicant respectfully submits that claim 1 is not anticipated by *Kropfield*. Claims 4 and 6-10 are also not anticipated by *Kropfield*, because they depend from claim 1.

Rejections under 35 U.S.C. §103(a)

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2003-211063 in view of *Kropfield* (U.S. Patent 5,810,254) in view of *Leidner* (U.S. Patent 6,056,993). This rejection relies on the rejection under 35 U.S.C. §102(b). Since the rejection under 35 U.S.C. §102(b) has been overcome, this rejection is also overcome.

Patentability of New Claims 21-25

New claims 21-25 are patentability for at least the same reasons why claim 1 is patentable.

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 07-1850.

Respectfully submitted,

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